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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,842	01/30/2004	Yasuyuki Higashiura	040033	4101

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EXAMINER	
KIM, JUNG W	
ART UNIT	PAPER NUMBER
2432	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,842	HIGASHIURA ET AL.	
	Examiner	Art Unit	
	JUNG KIM	2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to the RCE filed on 7/30/08.

2. Claims 1-13 and 15-21 are pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/30/08 has been entered.

Response to Arguments

4. Applicant's prior art arguments with respect to the amended claims have been considered but are not persuasive.

5. Contrary to Applicant's arguments that Bacha fails to disclose two check codes made by an encryption algorithm unique to the system (Remarks, pgs. 10-11), Bacha expressly discloses a first check code applied to an electronic data ("The application running in the application server's vault then signs the document it has received"; col. 6:64-65) and a second check code is applied to a digital signature ("the application running in the application server's vault notarizes the signature (block 310) by re-signing

it with its own private signing key"; col. 6:41-44). Furthermore, Bacha expressly discloses a signature is computed by encrypting a digest of a document, which is an image generated by applying a one-way function to the document, using the private key of the signer. (col. 6:1-34) Hence, contrary to Applicant's arguments, Bacha expressly discloses two check codes made by an encryption algorithm unique to the system from hash values. The encryption algorithm is unique to the system because it utilizes the application server's private key. Col. 6:43-44.

6. Finally, Applicant's arguments that Bacha fails to disclose creating an electronic signature for registration by encrypting a hash value of the electronic data with a secret key, and second check code is created by an encrypting method unique to the system from the electronic signature for registration, is not persuasive because Bacha in fact discloses generating an electronic signature for registration (a document is signed before being forwarded to the application server's vault for filing in the document database; col. 5:61-65; 6:38-39). Moreover, the electronic signature is generated by encrypting a hash value of the document using the signer's secret key (col. 6:1-34), and the application server notarizes the signature by re-signing it with its own private key. Col. 6:41-45. Hence, Bacha discloses the aforementioned limitation.

7. For these reasons, the claims remain rejected under the prior art of record.

Claim Rejections - 35 USC § 102

8. Claims 1-5 and 11-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated Bacha et al. USPN 6,950,943 (hereinafter Bacha).

9. As per claims 1, 3 and 4, Bacha discloses an electronic data storage system comprising:

a. a file device for storing at least electronic data (fig. 2, reference no. 204); and

b. a data processing unit which generates a first check code for detecting falsification of said electronic data and a second check code for detecting falsification of a public key-based electronic signature using a secret encryption method and/or an encryption key when the electronic data is registered (Col. 5:60-65; 6:12-15; 6:41-45; 7:1-3),

c. stores said electronic data, said public key-based electronic signature, and said first and second check codes into said file device (7:9-12),

d. respectively verifies the validity of said stored electronic data and said electronic signature using said first and second check codes when said electronic data is output, and then accesses said electronic data and said electronic signature when said validity is confirmed; (7:12-25; 8:15-54)

e. wherein the data processing unit generates the first check code from said electronic data by an encryption method unique to said system (6:1-33 and lines 54-65), generates an electronic signature for registration by encrypting a hash value of said electronic data with a secret key (5:64-65), and generates said second check code by an encrypting method unique to the system from said electronic signature for registration (6:59-63), and wherein said data processing

unit verifies the validity of said stored electronic data and said electronic signature by creating a third check code from said electronic data by said encrypting method unique to said system and a fourth check code from said electronic signature for registration by said encrypting method unique to said system, compares said first check code with said third check code and said stored second check code with said fourth check code (7:12-16; 8:17-18) and outputs said electronic data and said electronic signature when there is a match; (8:43-45)

f. wherein said data processing unit outputs said electronic data, the public key-based electronic signature and a second key-based electronic signature created at access to the public key-based electronic signature and the electronic data after verifying the validity of said electronic data and said electronic signature. (8:43-45, non-repudiation receipt includes the notarized signature and the requestor's vault signature)

10. As per claims 2 and 5, Bacha discloses an electronic data storage system comprising:

g. a file device for storing at least electronic data (fig. 2, reference no. 204); and

h. a data processing unit which generates a check code for detecting falsification of a public key-based electronic signature using a secret encryption

method and/or an encryption key when the electronic data is registered (Col. 5:60-65; 6:12-15; 6:41-45; 7:1-3),

i. stores said electronic data, said public key-based electronic signature, and the falsification check codes into said file device (7:9-12),

j. verifies the validity of said electronic signature using the check code attached to said electronic signature (8:17-18); and verifies the validity of said electronic data using said electronic signature when said electronic data is output (8:19-22), and then accesses said electronic data and said electronic signature when said validity is confirmed (8:27-30);

k. wherein the data processing unit generates an electronic signature for registration by encrypting a hash value of said electronic data with a secret key (5:66-67) and generates said check code by a method unique to said system from said electronic signature for registration (6:59-63), and wherein said data processing unit verifies the validity of said stored electronic data by creating a second check code from said electronic signature for registration by said method unique to said system, and comparing said stored check code with said second check code (8:15-18);

l. wherein said data processing unit outputs said electronic data, the public key-based electronic signature and a second key-based electronic signature created at access to the public key-based electronic signature after verifying the validity of said electronic data and said electronic signature. (8:43-45, non-

repudiation receipt includes the notarized signature and the requestor's vault signature)

11. As per claims 11-13 and 15, they are claims corresponding to claims 1-5, and they do not teach or define above the information claimed in claims 1-5. Therefore, claims 11-13 and 15 are rejected as being anticipated by Bacha for the same reasons set forth in the rejections of claims 1-5.

Claim Rejections - 35 USC § 103

12. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacha in view of Bisbee et al. USPN 5,748,738 (hereinafter Bisbee).

13. As per claims 6-10, the rejections of claims 1-5 under 35 USC 102(e) as being anticipated by Bacha are incorporated herein. Bacha does not expressly disclose, wherein said data processing unit stores a certificate of the public key with which said electronic signature was created, simultaneously along with said electronic signature into the file device, when said electronic signature is created; wherein said data processing unit stores or outputs the expiration information of said public key certificate simultaneously; wherein said data processing unit stores a certificate of the public key with which said electronic signature is created, simultaneously along with said electronic signature into the file device, when said electronic signature is created; wherein said data processing unit stores or outputs the expiration information of said public key

certificate simultaneously; wherein said data processing unit creates a pair of said public key and said secret key according to a request for key creation, issues a request of issuing a public key certificate to a CA office, acquires a public key certificate, and stores said acquired public key certificate in said file device. Bisbee discloses a system and method for electronic storage of authenticated documents, wherein a Certificate authority issues a public key certificate to various subscribers to generate public key signatures, wherein the certificates are in accordance with X.509, wherein the certificates include an expiration period field to indicate the expiration of the certificate; wherein a first digital signature is generated from an electronic document using a first private key from a first certificate, and the first digital signature and first certificate are attached to the electronic document; whereupon a second digital signature is generated from the electronic document using a second private key from a second certificate, and the second digital signature and second certificate are attached to the electronic document then stored in an Authentication Center once the first digital signature is validated. (5:15-55; 7:15-22; 9:27-10:7; 10:50-64) It would be obvious to one of ordinary skill in the art at the time the invention was made for the invention of Bacha to include the features wherein said data processing unit stores a certificate of the public key with which said electronic signature was created, simultaneously along with said electronic signature into the file device, when said electronic signature is created; wherein said data processing unit stores or outputs the expiration information of said public key certificate simultaneously; wherein said data processing unit stores a certificate of the public key with which said electronic signature is created,

simultaneously along with said electronic signature into the file device, when said electronic signature is created; wherein said data processing unit stores or outputs the expiration information of said public key certificate simultaneously; wherein said data processing unit creates a pair of said public key and said secret key according to a request for key creation, issues a request of issuing a public key certificate to a CA office, acquires a public key certificate, and stores said acquired public key certificate in said file device. One would be motivated to do so to provide simple and efficient means to provide the certified public key used to verify the public key signature of the electronic document as known to one of ordinary skill in the art and as taught by Bisbee. Col. 2:64-3:11. The aforementioned cover the limitations of claims 6-10.

14. As per claims 16-21, they are claims corresponding to claims 6-10, and they do not teach or define above the information claimed in claims 6-10. Therefore, claims 16-21 are rejected as being unpatentable over Bacha in view of Bisbee for the same reasons set forth in the rejections of claims 6-10.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNG KIM whose telephone number is (571)272-3804. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/
Primary Examiner, AU 2432